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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/971,080	10/03/2001	Hitesh Shah	206004.00004	2094
22909 7590 07/10/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER THIER, MICHAEL	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 07/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/971,080

Applicant(s)

SHAH, HITESH

Examiner

Michael T. Thier

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s). *request for reconsideration*
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 55-62.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
see attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


DUC M. NGUYEN
SUPERVISORY PRIMARY EXAMINER
TECHNOLOGY CENTER 2600

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/22/2007 have been fully considered but they are not persuasive.

Applicant argues, the “sharing” of “one of a call forwarding and a voicemail service” between a “vehicular wireless telephone” of “a second wireless service provider” as recited and a “personal wireless telephone” of “a first wireless service provider” is not taught in any combination of the references.

In response to applicant's argument, the examiner respectfully disagrees. First, Herman teaches the idea of sharing services between devices (column 15 lines 36-38). He explains in column 6 lines 52-60 the many types of devices that may be used in the wireless network of his invention, where PDA's and cellular phones are clearly listed. Then, in column 8 lines 65 to column 9 line 2, it is explained that each service-providing device contains native services, which are services the device can provide without the help of another device. (i.e. voicemail, and call forwarding are services that are well known and are provided by cellular phones as a native service.) Herman also explains that the devices can have the same building blocks in column 14 lines 61-63, i.e. the service consuming and service providing devices can both be cellular phones. Therefore, the invention of Herman can clearly share the services of a first cellular phone and a second cellular phone (where voicemail and call forwarding are obvious and well know services provided by cellular phones). The examiner has even shown the Marchbanks reference which shows this idea of cellular phones utilizing the service

of voicemail in figure 6 item 100. Therefore, sharing a voicemail service between a first wireless telephone and a second wireless telephone can be clearly seen in the combination of Herman and Marchbanks.

The applicant further argues that the combination of Chennakeshu with Herman, Fitzgerald, and Marchbanks is pure hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant further argues, "...none of the four references in combination teach ...sharing a single service plan and a single billing report."

In response to applicant's argument, the examiner respectfully disagrees. The examiner has previously shown that the Fitzgerald reference clearly shows the limitation of sharing a single wireless service plan administered by the first wireless service provider or the second wireless service provider in figure 1. Figure 1 shows a PDA 124 and phone 130, which can connect through the HUB 100 to the cellular network 108.

Therefore, a single service plan with the cellular network, allows for multiple devices to connect to it with through the HUB device. Further, it is clear from Marchbanks that the idea of integrating all charges from the network the device is subscribed and from third party sources into a single bill in the abstract.

Applicant further argues, "Again, no reference applied by the examiner singly or in combination permits a subscriber to share "one of call forwarding and a voicemail service" between a "vehicular wireless telephone" of "a second wireless service provider" as recited."

In response to applicant's argument, the examiner respectfully disagrees. Please see the first response, which clearly explains the sharing of services such as voicemail service between two devices (i.e. two cellular phones). As for the idea of sharing services between a personal phone and a vehicular wireless telephone, the examiner then supplied the Chennakeshu reference, which clearly teaches a wireless telephone for use in vehicles. Therefore, one of ordinary skill in the art could have been motivated to use the vehicular wireless device as in Chennakeshu with the sharing of services between two cellular devices as in Herman. Which would thus allow for sharing of services between a personal device and a vehicular device. Further, the invention of Herman can clearly share the services of a first cellular phone and a second cellular phone (where voicemail and call forwarding are obvious and well know services provided by cellular phones). The examiner has even shown the Marchbanks reference which shows this idea of cellular phones utilizing the service of voicemail in figure 6 item

100. Therefore, sharing a voicemail service between a first wireless telephone and a second vehicular wireless telephone can be clearly seen in the combination of Herman, Marchbanks, and Chennakeshu.

Applicant further argues there is no motivation to combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivations are all clearly recited in the paragraphs following each explanation of the references combined.

The applicant further argues, "Rosener has no vehicular wireless telephone", and neither discloses or suggests, "rerouting a call...to the vehicular wireless telephone" as recited.

In response to applicant's argument, the examiner respectfully disagrees. First the examiner would like to point out that the idea of a vehicular wireless telephone was shown in the Chennakeshu reference. Next, Rosener was combined to show the detecting the proximity of the personal phone to the vehicle and routing the call to the

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vehicle phone. Rosener teaches the idea that a user walking to their car while in a call on their hand held phone, a Bluetooth discovery is made when the person gets close enough to the vehicle, and the call is then connected to a repeater of the vehicle to allow for the power signal strength to continue the call. (see par. 118) Further Rosener explains that the vehicle contains a microphone and speaker to allow for routing the call through (using Bluetooth) for hands free phone calls in par. 120. Therefore, the combination of references clearly teaches detecting the proximity of a personal phone to the vehicle and re-routing a call to the vehicle wireless telephone (i.e. through the speaker and microphone built in to the vehicle using the repeater of the vehicle).

Applicant further argues, "There is no disclosure or suggestion of "displaying MPEG encoded image data."

In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The prior art shows a display, which is explained to show the number dialed and call status information. Nowhere does it explain that it cannot display MPEG encoded data, and therefore the display could possibly be used to perform the intended use. Therefore, the intended use limitation in this claim can be met by the display of Chennakeshu.

Applicant further argues that the prior art does not teach “shared concierge service” and “transferring an electronic mail message”.

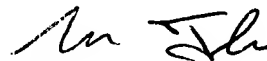
Again the examiner would like to point to the first response to arguments, which explains the sharing of services between two wireless devices. The examiner explained that the references did not teach that one of these services could be a concierge service (i.e. such as navigation), and for this reason Obradovich was shown. Obradovich teaches using services such as roadside assistance and navigation in a wireless vehicle phone, and as explained earlier when combined with Herman, the services could be shared between two wireless devices of different service providers. Therefore, the combination of references clearly shows the shared concierge service. Further, Herman teaches being able to share services such as email in figure 1. The idea of sharing mail between devices (i.e. between a service providing device and a service consuming device as in Herman) reads on transferring the email from one device to the other.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael T. Thier whose telephone number is (571) 272-2832. The examiner can normally be reached on Monday thru Friday 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael T Thier
Examiner
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7/3/2007